



Ana-Laura
Morales

Barcelona Court of Appeal confirms validity and infringement of Nescafé Dolce Gusto patents

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On 8 February 2019 the Barcelona Court of Appeal confirmed the January 2018 Barcelona Commercial Court Number 5 decision which had declared European Patent 1.472.156 (Spanish Patent 2.260.626) (EP'156) and European Patent 1.808.382 (Spanish Patent 2.407.963) (EP'382) – both of which related to Nescafé Dolce Gusto capsules – to be valid and infringed by Fast Eurocafé SA.

Facts

Société des Produits Nestlé, SA is the holder of EP'156 and EP'382, both of which protect the capsules of the well-known Nescafé Dolce Gusto system.

Patent EP'156 protects:

a capsule designed to be extracted by injection of a fluid under pressure in an extraction device, containing a substance for the preparation of a beverage, comprising a closed chamber containing the said substance and a means allowing the said capsule to be opened at the time of its use and for allowing the said beverage to flow out characterized in that opening is achieved by a relative engagement of the opening means with a retaining wall of the closed chamber and in that the relative engagement is performed under the effect of the rise in pressure of the fluid in the chamber.

The wording of EP'382 is very similar.

Since May 2015, Fast Eurocafé had been importing and selling beverage capsules which were compatible with the Nescafé Dolce Gusto system.

In January 2016 Nestlé filed a patent infringement action against Fast Eurocafé based on the abovementioned patents. At that time, Fast Eurocafé had launched two different types of capsule in the market:

- V1 capsules, which were opened in the middle (via so-called 'through holes'); and
- V2 capsules, which were opened at the edges (via so-called 'V openings') and, in some cases, featured the same openings as the V1 capsules.

Nestlé's main arguments were that the V1 and V2 capsules both fell within the scope of protection of EP'156 and EP'382.

Fast Eurocafé's arguments were as follows:

- The Nestlé patents were invalid due to a lack of novelty and inventive step in view of seven different prior art documents.
- The patents had not been infringed as:
 - the V openings of the V2 capsules did not require the lid to be torn or punctured. Rather, they required only a "detachment of the retaining wall from the cup"; and
 - there was no significant outflow of beverage via the through holes present on approximately 20% of V2 capsules.
- As regards the V1 capsules, Fast Eurocafé argued that they were not in the market when the complaint had been filed.
- In order to defend the non-infringement, Fast Eurocafé interpreted the scope of protection of Claim 1 of both patents in a restrictive way – namely, it argued that although Claim 1 of EP'156 does not state that the opening mechanism must tear or puncture the thin film of the closed chamber, the claim should be interpreted as if it did state this. Further, Fast Eurocafé held that Claim 1 of EP'382, which did specify the tearing feature, should be interpreted in a very restrictive manner.

Decisions

On 9 January 2018 Barcelona Commercial Court Number 5 declared that both of Nestlé's patents were valid and had been infringed by Fast Eurocafé.

Fast Eurocafé appealed the judgment. Nestlé opposed the appeal.

On 8 February 2019 the Barcelona Court of Appeal dismissed Fast Eurocafé's appeal and confirmed the judgment of Barcelona Commercial Court Number 5.

The main discussion in the appeal decision focused on the interpretation of the patents' scope of protection, on which the parties had disagreed.

The Barcelona Court of Appeal declared that claims must be interpreted according to the description. As Claim 1 of EP'156 does not specify that the capsules must be torn or punctured, but rather that the opening can have any shape or mechanism (of which the claim mentions several), the court held that Fast Eurocafé's interpretation of the claim had been incorrect.

As regards Claim 1 of EP'382, the court considered that although the claim specifies the tearing feature, as the description expressly states that the word 'tearing' must be understood in a broad sense, Fast Eurocafé's interpretation was unjustified.

Thus, the Court of Appeal confirmed that the controversial V1 and V2 capsules fell within the patents' scope of protection. With this decision, the court ratified its 18 May 2017 *prima facie* decision issued in the preliminary injunction proceedings of this case, in which it had granted the preliminary injunction measures requested by Nestlé.

In the present judgment, following an in-depth analysis of both parties' evidence, the Barcelona Court of Appeal held as follows:

- Even if the V openings of V2 capsules did not tear or puncture the film and Fast Eurocafé's argument that there was a mere separation or detachment of the film was correct, this way of opening the capsules fell within the scope of protection of Nestlé's patents as – even without tearing or puncturing the film – it allowed the capsule to be opened so that the beverage would flow out, thus preventing cross-contamination.
- The court stated that the through holes also fell within the patents' scope of protection due to the fact that there was a puncturing of the thin film which, even though minimal, allowed for an outflow of beverage.

As regards the nullity actions filed by Fast Eurocafé, the Barcelona Court of Appeal completely dismissed the defendant's arguments in full, finding the patents to be valid over the state of the art invoked in the counterclaim.

Comment

Considering the importance of the Nescafé Dolce Gusto system for Nestlé and the increased interest among competitors in commercialising compatible capsules, this judgment is of paramount importance as it confirms:

- the interpretation of the patents' scope of protection; and
- the patents' validity.

Fast Eurocafé has filed an extraordinary cassation appeal against this judgment to bring the case to the Supreme Court.

For further information on this topic please contact Ana-Laura Morales at Grau & Angulo by telephone (+34 93 202 34 56) or email (l.morales@ga-ip.com). The Grau & Angulo website can be accessed at www.ga-ip.com.

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